

## **REMARKS**

Applicants gratefully acknowledge the indication in the Final Office Action at page 2 that certain rejections have been withdrawn.

### **Information Disclosure Statement**

The Final Office Action at pages 2-4 addresses Applicants' previously submitted Information Disclosure Statement but indicates that, notwithstanding their previous comments, the IDS fails to comply fully with 37 C.F.R. 1.98(a)(2) with respect to certain cited documents that were apparently not provided by WIPO. In particular, although Applicants' had provided counterpart U.S. patents and published applications of several of the cited documents and had provided copies of other apparently missing documents, the Final Office Action would not consider any of the documents, even though some of the references were provided as full English translations (i.e., the Kessler et al article, the Harvey et al article, and the Tabuchi et al article) and both an original copy and English abstract were provided for a fourth article (i.e., the Hannig et al article).

Applicants therefore now submit a Supplemental Information Disclosure Statement that refers to the published U.S. counterparts of the previously identified foreign patent applications (i.e., the counterparts of WO 03/010149, WO 02/38542, and EP824099) and that refers to the four articles rather than the Chemical Abstracts citations.

Applicants therefore submit that they have fully complied with 37 C.F.R. 1.98 and respectfully request consideration of the cited documents.

### **Restriction Requirement under 35 U.S.C. 121**

Applicants acknowledge that Claim 29 remains withdrawn. However, because Applicants believe that the current claims are allowable, they have not canceled Claim 29 but again request rejoinder.

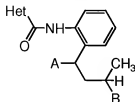
As before, Applicants reserve the right to file one or more divisional applications directed to non-elected subject matter.

### **Rejection under 35 U.S.C. 103**

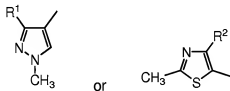
Claims 19-21, 23, 24, and 28 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,965,774 ("Yoshikawa et al"). [This patent is a counterpart of EP 0824099, which was cited by Applicants on their Form PTO 1449 but was struck out by the Examiner.] Applicants respectfully traverse.

Applicants note that the Final Office Action at 5 has again applied a dictionary meaning of the word "control" as used in Claim 28 that generally appears to comport with an understood meaning used by those skilled in the agrochemical arts, namely "to reduce of the incidence or severity of especially to innocuous levels" (which the web site exemplifies by referring to "control [of] an insect population").

As fully discussed in their previous Amendment dated July 14, 2009, Yoshikawa et al discloses a very narrowly defined set of plant disease controlling carboxanilide derivatives having the formula



(redrawn by Applicants to show more clearly the nature of the terminal groups of the alkyl side chain) in which **A** is hydrogen or methyl, **B** is methyl or ethyl (except that **A** is not methyl when **B** is ethyl), and **Het** has one of the formulas

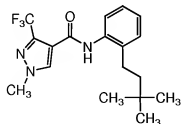


(where **R<sup>1</sup>** is trifluoromethyl or difluoromethyl and **R<sup>2</sup>** is trifluoromethyl, difluoromethyl, or methyl), as well as compositions thereof and various intermediates used to prepare such compounds. E.g., column 4, lines 22-66, and following text. It is clear that Yoshikawa et al does not teach or suggest compounds in which the alkyl side chain can terminate with three groups attached to one carbon atom.

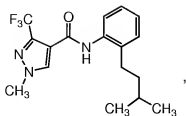
Applicants, in contrast, require their group **R<sup>3</sup>** to be halogen, alkyl, or haloalkyl, meaning that the alkyl side chain of their claimed compounds must terminate with three groups attached to one carbon atom (such as, for example, -C(CH<sub>3</sub>)<sub>3</sub>, also known as t-butyl, present in the inventive test compound discussed below).

The Final Office Action again relies on *In re Wood, Whittaker, Stirling, and Ohta*, 199 USPQ 137, 582 F2d 638 (C.C.P.A. 1978), to conclude that hydrogen and methyl substitutions are known in the art and that replacing a methyl with a hydrogen at the alkyl C-1 position and replacing a hydrogen with a methyl at the alkyl C-3 CS8772

position would lead those skilled in the art from Yoshikawa et al to their claimed invention. However, the Final Office Action apparently fails to recognize that the court concluded only that the claims then at issue “would have been expected to have similar properties to the structurally similar . . . compound” (see 199 U.S.P.Q. at 140 (emphasis added)) and has improperly ignored the well established principle that even structurally similar inventions can be patentably distinct under certain circumstances. E.g., *U.S. v. Adams*, 383 U.S. 39, 148 U.S.P.Q. 479 (1966). See also recent decisions such as *Takeda Chemical Industries v. Alphapharm*, 83 U.S.P.Q.2d 1169, 492 F.3d 1350 (Fed. Cir. 2007), and *Sanofi-Synthelabo v. Apotex*, 550 F.3d 1075, 89 U.S.P.Q.2d 1370, 1379-1380 (Fed. Cir. 2008), both of which support the proposition that obviousness can be overcome by evidence of unexpected and unpredictable properties, even under the liberal standards set forth in *KSR International v. Teleflex*, 82 U.S.P.Q.2d 1385, 1386, 550 U.S. 398 (2007). Applicants submit that their showing of unexpected superiority of hydrogen over methyl or methyl over hydrogen is indicative of unobviousness. That is, even if – as suggested by the Final Office Action – one were to ignore the likely biological consequences of the known greater steric bulk of the t-butyl (i.e.,  $-\text{C}(\text{CH}_3)_3$ ) group compared to the less bulky isopropyl (i.e.,  $-\text{CH}(\text{CH}_3)_2$ ) and ethyl (i.e.,  $-\text{CH}_2\text{CH}_3$ ) groups allowed by the reference, Applicants submit that the comparison data presented in the Declarations of Dr. Ulrike Wachendorff-Neumann and Dr. Peter Dahmen overcome any inference of obviousness for the compounds at issue. As previously pointed out, these data were obtained in tests carried out at three different application rates against four different organisms, all of which data show the clear superiority of Applicants’ inventive compound having the formula



(which corresponds to a compound of their formula (I) in which  $\text{R}^3$  is  $\text{CH}_3$  such that the alkyl side chain terminates with a t-butyl group) when compared with the corresponding compound of Example 4 of Yoshikawa et al having the formula



(in which the alkyl side chain has a isopropyl terminal group). Applicants maintain that those skilled in the art would not have expected such differences.

Applicants are mindful that (as pointed out in the Final Office Action) the compounds used in the comparison experiments have a CF<sub>3</sub> substituent rather than a CHF<sub>2</sub> substituent as found in the elected species. Applicants, however, submit that the inventive trifluoromethyl compound of these experiments falls within the scope of their desired claims and would, in any case, support the proposition being argued, namely, that the nature of the alkyl side chain is a critical feature that is being demonstrated by their experiments. Even if indirect in this sense, Applicants maintain that their experiments provide at least indirect support for the allowability of their claimed invention. The Final Office Action itself goes on to address this point by asserting that Applicants' data are not persuasive because the comparison compounds, though inferior, are still effective against the fungi tested. Applicants submit that the first observation is not fatal to their argument and that the second observation ignores the fact that their compound is unexpectedly more effective against a series of fungi. As discussed above, it is judicially recognized that obviousness can be overcome by evidence of such unexpected properties.

Applicants therefore submit that they have shown that their claimed invention is not rendered obvious by Yoshikawa et al.

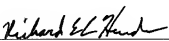
#### Double Patenting Rejections

The claims have been rejected under the judicially created doctrine of obviousness-type double patenting over various claims of one issued patent (formerly copending) and seven still copending applications. That is, Claims 19-21, 23, 24, 26, and 28 stand rejected over specified claims of U.S. Patent 7,358,214 and U.S. Application Serial Nos. 10/484,108 (published as US 2004/0204470), 10/576,050 (published as US 2007/0072930), 10/576,153 (published as US 2007/0196406), 10/583,312 (published as US 2007/0276022), 10/557,083 (published as US 2007/0066673), 10/597,723 (published as US 2007/0203148), and

10/576,243 (published as US 2007/0037858). Although Applicants believe that their claimed invention is patentably distinct from the cited patent and each of the copending applications, Applicants will submit an appropriate terminal disclaimer as suggested in the Final Office Action if their claims are otherwise found allowable.

In view of the preceding amendments and remarks, allowance of the claims is respectfully requested.

Respectfully submitted,

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